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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,531	06/09/2000	Lawrence Bernard Kool	RD-27,817	3236
6147	7590	01/29/2003	EXAMINER ANYA, IGWE U	
GENERAL ELECTRIC COMPANY GLOBAL RESEARCH CENTER PATENT DOCKET RM. 4A59 PO BOX 8, BLDG. K-1 ROSS NISKAYUNA, NY 12309			ART UNIT 2825	PAPER NUMBER
DATE MAILED: 01/29/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/591,531	KOOL ET AL.
	Examiner Igwe U. Anya	Art Unit 2825
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
<p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>18 November 2002</u>.</p> <p>2a)<input checked="" type="checkbox"/> This action is FINAL. 2b)<input type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>		
Disposition of Claims		
<p>4)<input type="checkbox"/> Claim(s) <u>1-22 and 24-48</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-22,34-37 and 42-48</u> is/are rejected.</p> <p>7)<input checked="" type="checkbox"/> Claim(s) <u>24-33 and 38-41</u> is/are objected to.</p> <p>8)<input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>		
Application Papers		
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p>		
<p>11)<input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner.</p> <p style="margin-left: 20px;">If approved, corrected drawings are required in reply to this Office action.</p>		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
<p>13)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p>1.<input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>* See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).</p> <p>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p>		
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
<p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .</p> <p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____ .</p>		

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 6, 9, 10, 12, 13, 15, 17, 18, 19, 22, 34, and 36 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagaei et al. (Abstract of JP Patent Number 56096083).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaei et al. (JP Patent Number 56096083) in view of O'Brien (US Patent Number 5817182).

6. Nagaei et al. teach the features previously outlined, but lack the step of forming the fluosilicic acid *in situ* by reacting silicon dioxide with hydrogen fluoride.

7. However O'Brien teaches the step of forming fluosilicic acid *in situ* by reacting silicon dioxide with hydrogen fluoride (column 2 lines 47 – 55).

8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of O'Brien into the method of Nagaei et al. to provide hydrofluosilicic acid *in situ*. Provision for adjustability where needed involves ordinary skill in the art.

9. Claims 3, 4, 11, 14, 16, 20, 21, 35, 37, 42 to 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaei et al. (JP Patent Number 56096083) in view of Matsukawa (US Patent Number 5962145).

10. Nagaei et al. teach the features previously outlined, but lack the step of:
the concentration of the acid being between 0.05 – 3.5M;
the concentration of the additional acid being between 0.1 – 20M;
the additional acid being a mineral acid having a pH of less than about 3.5 in pure water; and

immersing the substrate in bath in the range of about 10 minutes to about 72 hours.

11. However, Matsukawa teaches the steps of:

the concentration of the acid and the additional acid (column 3 lines 37 – 65);
the additional acid being a mineral acid having a pH of less than about 3.5 in
pure water, and the treatment time (column 6 table 1);

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Matsukawa into the Nagaei et al. reference to etch a coating. Discovering an optimum value for a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

13. Claims 24 – 33, and 38 to 41 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form.

14. Prior art considered but not used in the rejections include Lada et al. (US Patent Number 4339282), Kircher et al. (US Patent Number 6036995), and Jaworowski et al. (US Patent Number 6176999)

Remarks

15. Applicant's arguments filed November 18, 2002 have been fully considered but they are not persuasive. The overlay coating on the aluminum substrate is formed during annealing step, which is a high temperature oxidation. In response to applicant's argument that the combination of Nagaei and Matsukawa does not constitute a proper *prima facie* case of obviousness, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references

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would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicant is reminded that patentability is on claims and not specification.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igwe U. Anya whose telephone number is (703) 308-3549. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (703) 308-1323. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Igwe U. Anya
Examiner
Art Unit 2825

IA

January 26, 2003



MATTHEW SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800